

REMARKS

In the Office Action, the Examiner objected to the specification because of informalities, rejected claims 1-26 under the judicially created doctrine of obviousness-type double patenting over claims 1-16, 20, 22, 24, and 28-32 of U.S. Patent No. 6,660,068; rejected claims 1-8, 11-15, 20-28 and 30 under 35 U.S.C. § 102(b) as being anticipated by WO 94/07008 to Beines; rejected claims 1-3, 6-9, 11-13, 20, 21, 23-27 and 30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,044,157 to Henkel; and rejected claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Beines in view of U.S. Patent No. 4,954,263 to Woodhouse; and allowed claims 31-36.

Applicants thank the Examiner for the allowance of claims 31-36. The Examiner's reasons for allowance may contain some characterizations to which Applicants do not necessarily subscribe. Therefore, Applicants submit that the scope of the claims should not be limited by these characterizations.

Applicant has amended claims 1, 4, 19, 20, 21, 23, 26, 27, 31 and 36, and cancelled claims 2 and 29. Claims 1, 3-28, and 30-36 remain pending in this application.

With respect to the obviousness-type double patenting rejection of claims 1-26, Applicants respectfully submit that the concurrently filed Terminal Disclaimer obviates the rejection. Applicants request withdrawal of the obviousness-type double patenting rejection of claims 1-26.

Applicants respectfully traverse the rejection of claims 1-8, 11-15, 20-28 and 30 under 35 U.S.C. § 102(b) as being anticipated by Beines for at least the reason that Beines fails to disclose every element of the claimed invention. For example, Beines at

least fails to disclose "at least one first electrode...located near to but spaced apart upstream from an upstream end of the filter or downstream from a downstream end of the filter," as recited by independent claims 1 and 20, as amended. Beines discloses filter regeneration by spark discharge. Beines does not disclose any electrodes (2-6) upstream from any portion of the filter 20. (Fig. 2).

With respect to amended independent claim 26, the subject matter of claim 10, which was not rejected with a prior art rejection, is incorporated into claim 26 with the amendment. Beines fails to disclose at least "one of said electrodes comprises a surface electrode in the form of a layer of conducting material impregnatedly bonded to or deposited on an end surface of the filter," as recited in claim 26, as amended. Beines fails to disclose any electrodes on an end surface of the filter, much less a surface electrode in the form of a layer.

With respect to amended claim 27, Beines fails to disclose at least "means for electrically stabilizing the electrode arrangement, wherein said stabilizing means includes a resistor." Illustrative of the disclosure, Figures 1 and 2 of Beines clearly lack a resistor, and no equivalent resistor is disclosed in the specification.

Independent claims 1, 20, 26 and 27 are, therefore, allowable at least for the reason that Beines fails to disclose every element of the claimed invention. Claim 2 is cancelled, obviating any rejection of the claim. Claims 3-8, 11-15, 21-25, 28 and 30 each depend from an allowable independent claim, and are thus allowable at least due to their dependence from an allowable claim. Accordingly, the rejection of claims 1-8, 11-15, 20-28 and 30 under 35 U.S.C. § 102(b) should be withdrawn.

Applicants respectfully traverse the rejection of claims 1-3, 6-9, 11-13, 20, 21, 23-27 and 30 as being anticipated by Henkel for at least the reason that Henkel fails to disclose every element of the claimed invention. For example, Henkel fails to disclose at least "at least one first electrode...located near to but spaced apart upstream from a first upstream end of the filter or downstream from a second downstream end of the filter," as recited by independent claims 1 and 20, as amended. Henkel discloses filter regeneration by spark discharge. Henkel does not disclose any electrodes (2, 9) upstream from any portion of the filter 4. (Fig. 1).

With respect to amended independent claim 26, the subject matter of claim 10, which was not rejected with a prior art rejection, is incorporated into claim 26 with the amendment. Henkel fails to disclose at least "one of said electrodes comprises a surface electrode in the form of a layer of conducting material impregnatedly bonded to or deposited on an end surface of the filter," as recited in claim 26, as amended. Henkel fails to disclose any electrodes on an end surface of the filter.

With respect to amended claim 27, Henkel fails to disclose at least "means for electrically stabilizing the electrode arrangement, wherein said stabilizing means includes a resistor." The Office Action allegedly assigns an electrically stabilizing function to spacers 14 and 15. However, the spacers merely maintain a structural separation of the electrodes (2, 9) and do not provide an electrically stabilizing function. In fact, Henkel requires that the spacers have "as small a dielectric constant as possible," ensuring that the spacer disks do not interfere with the function of Henkel's system. (Col. 3, lines 55-58).

Independent claims 1, 20, 26 and 27 are, therefore, allowable at least for the reason that Henkel fails to disclose every element of the claimed invention. Claim 2 is cancelled, obviating any rejection of the claim. Claims 1, 3, 6-9, 11-13, 21, 23-25 and 30 each depend from an allowable independent claim, and are thus allowable at least due to their dependence from an allowable claim. Accordingly, the rejection of claims 1-3, 6-9, 11-13, 20, 21, 23-27 and 30 under 35 U.S.C. § 102(b) should be withdrawn.

Applicants respectfully traverse the rejection of claim 29 under 35 U.S.C. § 103(a) as being unpatentable over Beines in view of Woodhouse for at least the reason that no *prima facie* case of obviousness has been established. Although claim 29 is cancelled, the subject matter of claim 29 is incorporated into independent claim 26 by the amendment. In the Office Action, the Examiner recognizes that Beines fails to disclose a resistor as a stabilizing means, and attempts to rely on Woodhouse to correct this deficiency. (Office Action at 4). However, one of ordinary skill in the art would not have looked to Woodhouse to modify Beines, as suggested by the Examiner. Woodhouse discloses the non-analogous inducement of coagulation in fluids. The device of Woodhouse creates a field, but does not create a field sufficiently strong to induce a discharge between its anode and diode, and is not intended to do so. (Abstract). Because there is no discharge, the device of Woodhouse does not function in the same way, and does not solve an even remotely related problem. One of ordinary skill in the art would not look to a disclosure of coagulating fluids with an electrical field without a discharge to stabilize the field of a regenerative filter designed to have electrical discharges between electrodes and across a filter element.

For at least this reason, no *prima facie* case of obviousness has been established with respect to claim 26. For at least this reason the claim is allowable over Beines in view of Woodhouse. Accordingly, the rejection of claim 29 under 35 U.S.C. § 103(a) should be withdrawn.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 31, 2005

By: 

F. Chad Copier
Reg. No. 54,047